

Application No. 10/039,370
Amendment dated June 7, 2004
Reply to Office Action of April 7, 2004

REMARKS

This amendment is submitted in response to the final Office Action mailed April 7, 2004. Claims 1-9 remain pending in the application and stand rejected over U.S. Patent No. 4,918,632 to York in view of U.S. Patent No. 3,970,397 to Armstrong. Claim 10 has been added by this amendment. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

As a preliminary matter, Applicant notes that an initialed PTO Form-1449 has still not been provided by the Examiner, as requested in the Reply filed January 2, 2004. As noted therein, an IDS containing two pages of PTO Form-1449 was mailed on March 8, 2002 and was indicated as being received in the U.S. Patent and Trademark Office on March 12, 2002. Again, Applicant respectfully requests signed and initialed copies of the PTO Form-1449 in the next correspondence.

Claims Rejected Under 35 U.S.C. §103

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over York in view of Armstrong. While the Examiner admits that York does not teach each and every element of the claims, as noted in the reply mailed January 2, 2004, the Examiner continues to apply Armstrong, alleging that it would have been obvious to modify York as taught by Armstrong to produce the claimed invention. Applicant traverses and respectfully requests reconsideration of the asserted application of Armstrong. Specifically, Armstrong is directed to a business card system configured to

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be usable with a variety of business card holders, such as a Rolodex® or other similar business card holding device. The holes 32 and slots 22, 48, 50 referred to by the Examiner are formed in paper cards 10 upon which information from business cards may be written or upon which the business card may otherwise be secured, for example, by stapling.

The Examiner's characterization of the paper cards 10 of Armstrong being analogous to the claimed calculator as "an information carrier/data storage device" wholly ignores the specification and claims of the present invention, which are directed to a calculator. In particular, the cards 10 of Armstrong are not capable of performing mathematical functions or calculations, particularly necessary for flight planning and navigation, as disclosed in the specification. Accordingly, Applicant asserts that Armstrong does not teach or suggest a modification of York which would produce the claimed invention.

Moreover, Applicant asserts that one of ordinary skill in the art would not have been motivated to modify the computer of York in view of the business card system of Armstrong, as alleged by the Examiner. In this regard, Applicant notes that the mere fact that the elements of a claimed invention are known in the art is not, of itself, sufficient basis for an obviousness rejection. MPEP §2143.01; In re Katzab, 55 USPQ.2d 1313 (Fed. Cir. 2000). Rather, there must be some motivation, teaching or suggestion in the prior art to make the combination, either explicitly or implicitly. Id. "The mere fact that the prior art may be modified in the manner suggested by the

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Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

In this case, Armstrong does not suggest the desirability of providing different sets of apertures on adjacent sides of a calculator so that the calculator can be mounted in different types of ring binders. The Examiner has simply alleged a motivation to combine the references based on the presence of seemingly similar elements that the Examiner has located in the cited references. This is clearly hindsight reconstruction using Applicant's own disclosure. The Federal Circuit has repeatedly held that "[i]t is impermissible to use the claimed invention as an instruction manual or a 'template' to piece together the teachings of the prior art so that claimed invention is rendered obvious." Fritch at 1704.

Armstrong does not teach a computer or calculator that is configured to be mounted in a variety of formats of ring binders. There is no teaching or suggestion cited by the Examiner, in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the computer of York so that it can be received in ring binders of various formats. In this regard, Applicant further notes that Armstrong only discloses a single configuration of holes 32 for mounting cards 10 in a ring binder. The slots 22, 48, 50 provided on bottom border 20 are intended for mounting on standard roll, wheel, or arched tray-type index card holders. Armstrong does not teach or suggest first and second adjacent edges having different

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sets of apertures "wherein one set of apertures is sized and spaced to fit a first ring binder having four rings proximate one corresponding edge of the binder, and said another set of apertures is sized and spaced to fit rings of a second ring binder with rings disposed proximate another corresponding adjacent edge of the second binder," as recited in claim 2 (emphasis added).

Moreover, Armstrong does not teach or suggest configurations of apertures that are sized and spaced to fit an FAA chart binder and a Jeppesen® chart binder, as recited in claim 3, or one of a Jeppesen® chart binder in a three-ring binder, as recited in claim 4.

In further support of the nonobviousness of the claimed invention, Applicant submits, on even date herewith, a declaration attesting to the commercial success of the invention. As set forth therein, the inventive ring-mounted calculator has enjoyed commercial success since its introduction, and has taken sales from its predecessor. This commercial success is attributable to the inventive features recited in the pending claims. For at least the reasons set forth above, Applicant respectfully requests that the rejections of claims 1-9 be withdrawn.

New Claim

New claim 10 has been added by this amendment and is similar to originally filed claim 5. Claim 10 further recites that a plurality of second and third apertures disposed on a second edge of the housing comprise hole shaped apertures

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and slot shaped apertures disposed in an alternating arrangement. Support for this amendment can be found in the Application at page 4, lines 21-25, and with reference to Fig. 1. Accordingly, Applicant submits that no new matter has been added by claim 10. Applicant further asserts that claim 10 is not taught or suggested by the cited references. Specifically, neither York nor Armstrong teach or suggest a ring mountable calculator comprising a housing with apertures and slots arranged in an alternating pattern along a second edge of the housing.

In view of the foregoing amendments to the claims and remarks given herein, Applicant respectfully believes this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicant is of the opinion that no additional fee is due as a result of this amendment. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

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